

REMARKS

This is a full and timely response to the Final Office Action (Paper No. 7) mailed by the U.S. Patent and Trademark Office on February 11, 2003. Claims 1-39 remain pending in the present application. Claims 1-4, 6, 11, 13, 14, 16, 17, 20-22, 25, 26, 30-32, and 35-38 have been amended to more particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. Support for the subject matter added to independent claims 1, 16, 20, 26, and 37 can be found at least in Applicant's FIGs. 4, 5, 7, and 10 and the related detailed description. Consequently, Applicant submits that the claim amendments add no new matter to the present application. Applicant requests entry of the amendments. In view of the foregoing amendments and the following remarks, reconsideration and allowance of the present application and claims are respectfully requested.

I. Response to Claim Objections – Claims 16 and 37

A. Statement of the Objection

Claims 16 and 37 are objected to because of informalities. Concerning claim 16, the Office Action alleges: "In Claim 16, line 7, 'the source' lacks proper antecedent basis." Regarding claim 37, the Office Action alleges: "In Claim 37, line 3, 'a source' lacks proper antecedent basis, as it is already previously defined in line 1."

B. Discussion of the Objection

Applicant has amended claim 16 such that "the source" recited in claim 16 has proper antecedent basis. Specifically, line 3 has been changed to reflect "a source." Applicant has also amended claim 37 such that it states "the source" in line 3.

Accordingly, claims 16 and 37 have been appropriately corrected and the objection to claims 16 and 37 should be withdrawn.

II. Claim Rejections Under 35 U.S.C. §102 – Claims 1, 2, 8-11, 13 and 20 / Claim 37

A. Statement of the Rejections

Claims 1, 2, 8-11, 13, and 20 presently stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Griffin* (U.S. Patent No. 6,233,064, hereafter *Griffin*.)

Claim 37 presently stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Nagano et al.* (U.S. Patent No. 6,331,886, hereafter *Nagano*.)

B. Discussion of the Rejections

Applicant respectfully traverses the rejection of claims 1, 2, 8-11, 13 and 20 for at least the reason that the document scanner apparently disclosed in *Griffin* fails to disclose, teach, or suggest each element in Applicant's claims.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior-art reference disclose each element, feature, or step of the claim. See e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

Griffin is apparently directed to a self-supporting cabinet for housing a two-dimensional reader means having a transparent vertically-oriented window. A document support ledge is horizontally placed parallel to the lower external edge of the window. The document support ledge keeps a document, with an image to be scanned, from falling down. A magnet on the top of the cover can be used to keep the cover from falling down. In addition, a second set of feet are added to the cabinet housing to support the scanner from its new bottom. *Griffin* - Summary of the Invention, column 2, lines 23-32.

In this regard, the Office Action mailed February 11, 2003 alleges that the document support ledge (16) of *Griffin* teaches the Applicant's channel. Applicant respectfully disagrees.

Claim 1

For convenience of analysis, Applicant's independent claim 1, as amended, is repeated below in its entirety.

1. A space-saving scanner assembly, comprising:
a housing having a substantially vertical source-contact surface with a channel extending from the

housing, said channel having a surface that is substantially parallel to, and opposed from, said source-contact surface; and

a flap coupled to the source-contact surface, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and said channel form an aperture for receiving an edge of a source to be scanned.

(Applicant's independent Claim 1 - *Emphasis Added.*)

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the emphasized element of independent claim 1. Consequently, claim 1 is allowable.

Specifically, Applicant respectfully disagrees with the assertion in the Office Action that *Griffin* teaches a channel between window 30 and ledge 16. Applicant submits "*said channel having a surface that is substantially parallel to, and opposed from, said source-contact surface*" is not shown in *Griffin*. Fig. 1 of *Griffin* clearly illustrates, and the detailed description apparently describes, a document support ledge (16) as a flat projecting edge or molding intended to restrict movement of a document such that it does not fall off the window.

In this regard, *Griffin* apparently teaches five embodiments of a document support ledge (16, 116, 216, 316, and 416 in Figs. 1, 5-10, 14, and 17). Each of the five embodiments of the document support ledge (16, 116, 216, 316, and 416) show a raised or projecting edge or molding intended to restrict movement of a document such that it does not fall off the window. Significantly, each of the embodiments, including the preferred embodiment, do not show "*a surface that is substantially parallel to, and opposed from, said source-contact surface*" as recited in Applicant's claim 1. Consequently, *Griffin* fails to disclose, teach, or suggest at least this element of the claim.

Because *Griffin* does not disclose, teach, or suggest at least the emphasized element of claim 1 as shown above, Applicant respectfully submits that *Griffin* fails to anticipate claim 1. Consequently, independent claim 1, as amended, is allowable and the rejection of claim 1 should be withdrawn.

Claims 2, 8-11, 13

Because independent claim 1 is allowable, its respective dependent claims 2-15 are also allowable, as a matter of law, since these dependent claims contain all elements,

features, or steps of independent claim 1. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection of claims 2, 8-11, and 13 be withdrawn.

Claim 20

For convenience of analysis, Applicant's independent claim 20, as amended, is repeated below in its entirety.

20. A method for saving space on a desktop, comprising:

providing an optical scanner having a housing, the housing having a substantially vertical source-contact surface with a channel extending from the housing, the channel having a surface that is substantially parallel to, and opposed from, said source-contact surface, the vertical source-contact surface including a transparent platen portion, wherein the channel is adjacent to a lower edge of the transparent platen portion; and

providing a flap coupled to the source-contact surface, the flap having a source-backing surface substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the channel form an aperture for receiving a source to be scanned.

(Applicant's independent Claim 20 - *Emphasis Added.*)

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the emphasized method step of independent claim 20. Consequently, claim 20 is allowable.

Specifically, Applicant respectfully submits that "*providing an optical scanner having a housing, the housing having a substantially vertical source-contact surface with a channel extending from the housing, the channel having a surface that is substantially parallel to, and opposed from, said source-contact surface, the vertical source-contact surface including a transparent platen portion, wherein the channel is adjacent to a lower edge of the transparent platen portion*" is not shown in *Griffin*. Fig. 1 of *Griffin* clearly illustrates, and the detailed description apparently describes, a document support ledge (16) as a flat projecting edge or molding intended to check movement of a document such that it does not fall off the window.

As noted above, *Griffin* apparently teaches five embodiments of a document support ledge (16, 116, 216, 316, and 416 in Figs. 1, 5-10, 14, and 17). Significantly, each of the embodiments, including the preferred embodiment, do not show "*the channel having a surface that is substantially parallel to, and opposed from, said source-contact surface*," as recited in Applicant's claim 20. Consequently, *Griffin* fails to disclose, teach, or suggest at least this step of the claim.

Applicant respectfully submits that because *Griffin* does not disclose, teach, or suggest at least the emphasized step of claim 20 as shown above, *Griffin* fails to anticipate claim 20. Consequently, independent claim 20, as amended, is allowable and the rejection of claim 20 should be withdrawn.

Because independent claim 20 is allowable, its respective dependent claims 22-25 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or steps of independent claim 20. *In re Fine, supra*.

Claim 37

Applicant respectfully traverses the rejection of claim 37 for at least the reason that the film reader apparently disclosed in *Nagano* fails to disclose, teach, or suggest each element in the claim.

Nagano is apparently directed to an image reading apparatus constructed so that a film holder and an adapter can be selectively mounted to a film scanner that serves as an original placing board. A cartridge containing a dedicated film can be inserted into and removed from the adapter. Image information is read from the film in the film holder or the film in the cartridge by moving the original placing board. Further, the film or the cartridge can be exchanged in a condition where the film holder or the adapter is mounted to the film scanner. Abstract - *Nagano*.

In contrast with the presently claimed invention, the apparatus apparently disclosed in *Nagano* is directed to a film reader that arranges the film to be read using a cartridge or a film holder. The film reader apparently disclosed in *Nagano* comprises a mounting portion for mounting the holder, which holds a film original. The film original is able to be loaded and/or unloaded from the holder in a condition where the holder is mounted to the mounting portion. In a second embodiment, the reader comprises a loading slot for inserting a film original and transport means for transporting the film original for reciprocating motion from

the loading slot toward an inner side of the image reading apparatus. *Nagano*, column 2, lines 27-45.

For convenience of analysis, Applicant's independent claim 37, as amended, is repeated below in its entirety.

37. A method for arranging a source in a scanner comprising:

inserting a leading edge of the source into an aperture formed by a channel having a surface that is substantially parallel to, and opposed from, a platen of the scanner such that a surface of the source having information thereon that is desired to be imaged by the scanner is adjacent to a sensor arranged in a substantially vertical plane; and

adjusting the source such that the information desired to be imaged is aligned with the sensor.

(Applicant's independent Claim 37 - *Emphasis Added*.)

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the emphasized method step of independent claim 37. Consequently, claim 37 is allowable.

Specifically, Applicant respectfully submits that "*inserting a leading edge of the source into an aperture formed by a channel having a surface that is substantially parallel to, and opposed from, a platen of the scanner*." is not shown in *Nagano*. Fig. 1 of *Nagano* clearly illustrates, and the detailed description apparently describes, mounting portions 1a and 1b for mounting a film holder to the adapter II. The mounting portions for mounting a film holder as apparently shown in *Nagano* do not teach Applicant's "*channel having a surface that is substantially parallel to, and opposed from, a platen of the scanner*." Consequently, *Nagano* fails to disclose, teach, or suggest at least this step of the claim.

Applicant respectfully submits that because *Nagano* does not disclose, teach, or suggest at least the emphasized step of claim 37, *Nagano* fails to anticipate claim 37. Consequently, independent claim 37, as amended, is allowable and the rejection of claim 37 should be withdrawn.

Because independent claim 37 is allowable, its respective dependent claims 38 and 39 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or steps of independent claim 37. *In re Fine, supra*.

III. Claim Rejections Under 35 U.S.C. §103– Claims 3-7, 12, 14-19, 21-36, 38, and 39

A. Statement of the Rejections

Claims 7 and 14 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Griffin*.

Claims 3-6, 12, 16-19, and 21-36 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Griffin* in view of *Nagano*.

Claims 38 and 39 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Nagano*.

B. Discussion of the Rejections

Applicant respectfully traverses the rejection of these claims for at least the reason that the cited art references fail to disclose, teach, or suggest each element in the claims.

In order for a claim to be properly rejected under 35 U.S.C. §103, “[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (Citations omitted). To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this regard, the present rejections fail to meet the burden of disclosing, teaching, or suggesting each feature of the claimed invention. Furthermore, Applicant respectfully submits that the Office Action rejection has failed to recite a teaching or suggestion from the prior art suggesting that one should combine the apparent teachings of *Nagano*’s film reader with the apparent teachings of *Griffin*’s document scanner to render Applicant’s claimed invention obvious.

The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art and not based on the Applicant’s disclosure. In contrast with the presently claimed invention, the apparatus, apparently

disclosed in *Griffin* describes an inclined housing with a document support ledge and a flap that rests over a document that has been placed over a transparent window. Also in contrast with the presently claimed invention, *Nagano* includes a film reader that uses a cartridge and/or an adapter to arrange a film source with the film reader.

Consequently, in order to establish a *prima facie* case of obviousness, the Office Action must cite an objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the inclined housing of *Griffin* with the film reader of *Nagano* to reach the claimed invention. Applicant respectfully submits that one skilled in the art would not be motivated to save desktop space by combining the teachings of *Griffin* and *Nagano* for at least the reason that the cited references deal with entirely different source materials. *Griffin* apparently teaches a document and book scanner, whereas, *Nagano* apparently discloses a film reader.

Applicant submits that one skilled in the art when trying to minimize desktop space used by a scanner would not be inclined to combine the features apparently disclosed in *Griffin* with the features apparently disclosed in *Nagano* to reach the claimed invention. Thus, the proposed combination fails to establish a *prima facie* case of obviousness and is improper.

In this regard, the Office Action alleges that the cited references teach devices in the same field of optically scanning sources in the vertical direction. Applicant respectfully disagrees with the Office's determination of the scope of the prior art. A proper determination of the scope and content of the prior art starts with an examination of the field of "the inventor's endeavor," . . . and "the particular problem with which the inventor was involved," . . . at the time the invention was made. Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial & Trading Co., Ltd.*, 139 F.3d 877, 45 USPQ2d 1977 (Fed. Cir. 1998).

Applicant's problem at the time the invention was made was how to conserve desktop space while scanning a source document. Clearly the film reader of *Nagano* is not directed to scanning a source document. Consequently, the film reader of *Nagano* is not directed to conserving desktop space while scanning a source document. Thus it is clear that the Office is engaging in impermissible hindsight in its selection of the prior art relevant to obviousness with regard to the selection of *Nagano*. Accordingly, *Nagano* should not be considered within the scope of the prior art. Stated another way, Applicant's

solution of orienting a scanner such that the platen is substantially vertical and forming an aperture that closely receives a leading edge of a document and a channel means that concurrently supports and aligns a second edge of the source to permit scanning of the document without adjusting the aperture should not be considered when determining the scope of the prior art. Thus, the proposed combination of *Griffin* and *Nagano* is improper and the rejection of claims 3-7, 12, 14-19, 21-36, 38, and 39 should be withdrawn.

Claims 7 and 14

Applicant respectfully traverses the rejection of claims 7 and 14 as being unpatentable over *Griffin*.

Concerning the Office Action's interpretation of *Griffin*, Applicant has shown above, with regard to the response of the rejection of claim 1 under 35 U.S.C. §102(e) that *Griffin* does not disclose, teach, or suggest at least "*a housing having a substantially vertical source-contact surface with a channel extending from the housing, said channel having a surface that is substantially parallel to, and opposed from, said source-contact surface.*" Thus, Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the element of pending independent claim 1 highlighted above. Dependent claim 7 depends directly from claim 1. Claim 14 also depends directly from claim 1. Consequently, both claims 7 and 14 include all the limitations of independent claim 1 from which they depend. *See In re Fine, supra.* Therefore, claims 7 and 14 are allowable. Accordingly, for at least these reasons, the rejection of claims 7 and 14 should be withdrawn.

Claims 3-6, 12, and 15

Applicant respectfully traverses the rejection of claims 3-6, 12, and 15 as being unpatentable over *Griffin* in view of *Nagano*.

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant has shown above, with regard to the response of the rejection of claim 1 under 35 U.S.C. §102(e) that *Griffin* does not disclose, teach, or suggest at least "*a housing having a substantially vertical source-contact surface with a channel extending from the housing,*

said channel having a surface that is substantially parallel to, and opposed from, said source-contact surface." Furthermore, Applicant respectfully asserts that *Nagano* fails to remedy the failure of *Griffin* to disclose, teach, or suggest this element. Thus, Applicant respectfully asserts that the proposed combination of cited art references fails to disclose, teach, or suggest at least the element of pending independent claim 1 highlighted above. Dependent claims 3-6, 12, and 15 depends directly from claim 1. Consequently, claims 3-6, 12, and 15 include all the limitations of independent claim 1 from which they depend. See *In re Fine, supra*. Therefore, claims 3-6, 12, and 15 are allowable. Accordingly, for at least these reasons, the rejection of claims 3-6, 12, and 15 should be withdrawn.

Claims 16-19

Applicant respectfully traverses the rejection of claims 16-19 as being unpatentable over *Griffin* in view of *Nagano*.

For convenience of analysis, Applicant's independent claim 16, as amended, is repeated below in its entirety.

16. A space-saving scanner assembly, comprising:
means for housing an optical scanner; and
means for forming an aperture configured to closely receive a leading edge of a source, such that the source can be spatially arranged with the means for optically scanning without adjusting the aperture, the source being supported along a second edge of said source along a channel means as the source is received in the aperture, wherein said channel means extends from said means for housing and comprises a source retaining means substantially parallel to, and opposed from, said optical scanner.

(Applicant's independent Claim 16 - *Emphasis Added.*)

Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the emphasized element of independent claim 16. Consequently, claim 16 is allowable.

Specifically, Applicant respectfully disagrees with the assertion in the Office Action that *Griffin* teaches a channel between window 30 and ledge 16. Applicant submits that "*means for forming an aperture configured to closely receive a leading edge of a source, such that the source can be spatially arranged with the means for optically scanning*

without adjusting the aperture, the source being supported along a second edge of said source along a channel means as the source is received in the aperture, wherein said channel means extends from said means for housing and comprises a source retaining means substantially parallel to, and opposed from, said optical scanner" is not shown in *Griffin*. Fig. 1 of *Griffin* clearly illustrates, and the detailed description apparently describes, a document support ledge (16) as a flat projecting edge or molding intended to restrict movement of a document such that it does not fall off the window.

As noted above, *Griffin* apparently teaches five embodiments of a document support ledge (16, 116, 216, 316, and 416 in Figs. 1, 5-10, 14, and 17). Significantly, each of the embodiments, including the preferred embodiment, do not show "*a source retaining means substantially parallel to, and opposed from, said optical scanner*" as recited in Applicant's claim 16. Consequently, *Griffin* fails to disclose, teach, or suggest at least this element of the claim.

Applicant respectfully asserts that *Nagano* fails to remedy the failure of *Griffin* to disclose, teach, or suggest this element. Thus, Applicant respectfully asserts that the proposed combination of cited art references fails to disclose, teach, or suggest at least the element of pending independent claim 16 highlighted above. Dependent claims 17-19 include all the limitations of independent claim 16 from which they depend. Therefore, claims 17-19 are allowable. See *In re Fine, supra*. Accordingly, for at least these reasons, the rejection of claims 16-19 should be withdrawn.

Claims 21-36

Applicant respectfully traverses the rejection of claims 21-36 as being unpatentable over *Griffin* in view of *Nagano*.

Applicant has shown above, with regard to the response of the rejection of claim 20 under 35 U.S.C. §102(e) that *Griffin* does not disclose, teach, or suggest at least "*providing an optical scanner having a housing, the housing having a substantially vertical source-contact surface with a channel extending from the housing, the channel having a surface that is substantially parallel to, and opposed from, said source-contact surface, the vertical source-contact surface including a transparent platen portion, wherein the channel is adjacent to a lower edge of the transparent platen portion.*" Furthermore, Applicant respectfully asserts that *Nagano* fails to remedy the failure of *Griffin* to disclose, teach, or suggest these limitations. Thus, Applicant respectfully asserts that the proposed

combination of cited art references fails to disclose, teach, or suggest at least the limitations of pending independent claim 20 highlighted above. Dependent claims 21-36 depend from claim 20. Consequently, claims 21-36 include all the limitations of independent claim 20 from which they depend. See *In re Fine, supra*. Therefore, claims 21-36 are allowable. Accordingly, for at least these reasons, the rejection of claims 21-36 should be withdrawn.

Claims 38 and 39

Applicant respectfully traverses the rejection of claims 38 and 39 as being unpatentable over *Nagano*.

Concerning the Office Action's interpretation of *Nagano*, Applicant has shown above, with regard to the response of the rejection of claim 37 under 35 U.S.C. §102(e) that *Nagano does not* disclose, teach, or suggest at least "*inserting a leading edge of the source into an aperture formed by a channel having a surface that is substantially parallel to, and opposed from, a platen of the scanner*," as recited in Applicant's claim. Thus, Applicant respectfully asserts that the cited art of record fails to disclose, teach, or suggest at least the element of pending independent claim 37 highlighted above. Dependent claims 38 and 39 depend directly from claim 37. Consequently, both claims 38 and 39 include all the limitations of independent claim 37 from which they depend. See *In re Fine, supra*. Therefore, claims 38 and 39 are allowable. Accordingly, for at least these reasons, the rejection of claims 38 and 39 should be withdrawn.

CONCLUSION

In summary, Applicant respectfully requests that all outstanding claim rejections be withdrawn. Applicant respectfully submits that presently pending claims 1-39 are allowable and the present application is in condition for allowance. Accordingly, a Notice of Allowance is respectfully solicited. Should the Examiner have any comments regarding the Applicant's response or believes that a teleconference would expedite prosecution, Applicant requests that the Examiner telephone Applicant's undersigned attorney.

Respectfully submitted,

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**

By:

Robert A. Blaha
Robert A. Blaha
Registration No. 43,502
(770) 933-9500